

1 CHUCK P. EBERTIN (SBN 161374)  
 2 cebertin@velaw.com  
 3 VINSON & ELKINS LLP  
 4 525 University Avenue, Suite 410  
 Palo Alto, CA 94301-1918  
 Tel: (650) 687-8200  
 Fax: (650) 618-1970

5 Attorneys for Plaintiff  
 6 SANDISK CORPORATION

FILED  
 OCT 27 A 11: 56  
 DOCUMENTS  
 CLEVERLY

Rec'd  
 SI  
 (14)

7  
 8 UNITED STATES DISTRICT COURT

9 NORTHERN DISTRICT OF CALIFORNIA

10  
 11 SANDISK CORPORATION,

12 Plaintiff,

13 vs.

14 ROUND ROCK RESEARCH LLC,

15 Defendant.

ADR

Case No. CV 11-05243

COMPLAINT FOR DECLARATORY  
 JUDGMENT OF PATENT NON-  
 INFRINGEMENT AND/OR PATENT  
 INVALIDITY

DEMAND FOR JURY TRIAL

16  
 17  
 18 Plaintiff SanDisk Corporation ("SanDisk") hereby alleges as follows:

19 NATURE OF THE ACTION

20 1. This is an action for a declaratory judgment of non-infringement and/or invalidity of  
 21 United States Patent Nos. 5,682,345 ("the '345 patent"), 6,272,586 ("the '586 patent"), 6,570,791  
 22 ("the '791 patent"), 7,483,334 ("the '334 patent"), 6,383,839 ("the '839 patent"), 6,900,528 ("the  
 23 '528 patent"), 7,021,520 ("the '520 patent"), 6,255,209 ("the '209 patent"), 5,783,282 ("the '282  
 24 patent"), 5,286,344 ("the '344 patent"), and 6,015,760 ("the '760 patent").

25 THE PARTIES

26 2. Plaintiff SanDisk is a corporation organized and existing under the laws of Delaware,  
 27 and has its headquarters and principal place of business in Milpitas, California. SanDisk is engaged  
 28 in the business of, among other things, designing and selling flash memory products. SanDisk is a

1 global leader in flash memory storage solutions, from research and development, product design and  
2 manufacturing to branding and distribution for OEM and retail channels. Since 1988, SanDisk's  
3 innovations in flash memory and storage system technologies have provided customers with new  
4 and transformational digital experiences.

5 3. Defendant Round Rock Research, LLC ("Round Rock") is a Delaware limited  
6 liability company with its principal place of business at Mount Kisco, New York.

### 7 JURISDICTION

8 4. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 *et seq.*, and  
9 under the patent laws of the United States, Title 35 of the United States Code. This Court has  
10 jurisdiction over this action pursuant to 35 U.S.C. §§ 271 *et seq.*, and 28 U.S.C. §§ 1331, 1338, and  
11 2201-2202.

12 5. Venue is proper in this District under 28 U.S.C. §§ 1391 and 1400(b) because a  
13 substantial part of the events giving rise to the claims at issue occurred in this District.

14 6. This Court has personal jurisdiction over Round Rock by virtue of the business  
15 activities it conducts within the State of California and within this District, resulting in sufficient  
16 minimum contacts with this forum.

### 17 INTRADISTRICT ASSIGNMENT

18 7. This case is an Intellectual Property Action under Civil Local Rule 3-2(c) and,  
19 pursuant to Civil Local Rule 3-5(b), shall be assigned on a district-wide basis.

### 20 GENERAL ALLEGATIONS

21 8. The '345 patent issued on October 28, 1997 to named inventors Frankie Roohparvar  
22 and Michael Briner and is entitled "Non-volatile data storage unit method of controlling same."

23 9. The '586 patent issued on August 7, 2001 to named inventors Frankie Roohparvar,  
24 Darrell Rinerson, Christophe Chevallier and Michael Briner and is entitled "Memory system having  
25 programmable control parameters."

26 10. The '791 patent issued on May 27, 2005 to named inventors Frankie Roohparvar and  
27 Kevin Widmer and is entitled "Flash memory with DDRAM interface."

28

1           11.     The '334 patent issued on January 27, 2009 to named inventor Chang Ha and is  
2 entitled "Interleaved input signal path for multiplexed input."

3           12.     The '839 patent issued on May 7, 2002 to named inventor Larry Kinsman and is  
4 entitled "Vertically mountable semiconductor device and methods."

5           13.     The '528 patent issued on May 31, 2005 to named inventors Leonard Mess, Jerry  
6 Brooks and David Corisis and is entitled "Stacked mass storage flash memory package."

7           14.     The '520 patent issued on April 4, 2006 to named inventor Neal Bowen and is  
8 entitled "Stacked chip connection using stand off stitch bonding."

9           15.     The '209 patent issued on July 3, 2001 to named inventors Trung Doan, Gurtej  
10 Sandhu, Kirk Prall and Sujit Sharan and is entitled "Methods of forming a contact having titanium  
11 formed by chemical vapor deposition."

12          16.     The '282 patent issued on July 21, 1998 to named inventor Shane Leiphart and is  
13 entitled "Resputtering to achieve better step coverage of contact holes."

14          17.     The '344 patent issued on February 15, 1994 to named inventors Guy Blalock, David  
15 Becker and Fred Roe and is entitled "Process for selectively etching a layer of silicon dioxide on an  
16 underlying stop layer of silicon nitride."

17          18.     The '760 patent issued on January 18, 2000 to named inventors Guy Blalock, David  
18 Becker and Fred Roe and is entitled "Method for enhancing oxide to nitride selectivity through the  
19 use of independent heat control."

20          19.     The '345 patent, the '586 patent, the '791 patent, the '334 patent, the '839 patent, the  
21 '528 patent, the '520 patent, the '209 patent, the '282 patent, the '344 patent, and the '760 patent are  
22 collectively referred to herein as the "Round Rock Asserted Patents."

23          20.     Round Rock contends that it owns the Round Rock Asserted Patents.

24          21.     On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting  
25 ownership of the Round Rock Asserted Patents. Round Rock asserted that SanDisk flash memory  
26 products incorporate and use features and functionalities covered by the Round Rock Asserted  
27 Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either  
28

1 directly or indirectly.” Round Rock asserted that “SanDisk products utilizing Flash memory . . .  
2 infringe the Round Rock [Asserted] Patents.”

3 22. SanDisk does not believe that it is required to license the Round Rock Asserted  
4 Patents to make, use and sell its flash memory products.

5 **FIRST CAUSE OF ACTION**

6 **(Declaratory Judgment of Non-Infringement and/or Invalidity)**

7 23. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 22  
8 of this Complaint as though set forth in full herein.

9 24. Round Rock has asserted that “All SanDisk Flash memory products” infringe the  
10 Round Rock Asserted Patents.

11 25. SanDisk contends that it is not required to license the Round Rock Asserted Patents  
12 because SanDisk’s flash memory products have not infringed and do not infringe, either directly or  
13 indirectly, any valid claim of the Round Rock Asserted Patents.

14 26. As a result of the acts described in this Complaint, there exists a substantial  
15 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

16 27. An actual and justiciable controversy exists between SanDisk and Round Rock as to  
17 whether the Round Rock Asserted Patents are infringed by SanDisk’s flash memory products. A  
18 judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding  
19 the Round Rock Asserted Patents.

20 28. An actual and justiciable controversy exists between SanDisk and Round Rock as to  
21 whether the Round Rock Asserted Patents are valid. A judicial declaration is necessary and  
22 appropriate so that SanDisk may ascertain its rights regarding the Round Rock Asserted Patents.

23 **PRAYER FOR RELIEF**

24 WHEREFORE, SanDisk prays that this Court:

25 A. Issue a declaration that SanDisk’s flash memory products have not infringed and do  
26 not infringe, either directly or indirectly, any valid claim of the Round Rock Asserted Patents;

27 B. Issue a declaration that the claims of the Round Rock Asserted Patents are invalid;  
28



1 C. Issue an order enjoining Round Rock, its officers, agents, servants, employees,  
2 attorneys, parent and subsidiary corporations, assigns and successors in interest, and those persons in  
3 active concert or participation with them, from alleging that SanDisk and/or SanDisk's customers  
4 infringe any of the Round Rock Asserted Patents by making, using, selling, offering to sell or  
5 importing SanDisk flash memory products;

6 D. Issue an order declaring that SanDisk is the prevailing party and that this is an  
7 exceptional case under 35 U.S.C. § 285 and award SanDisk its reasonable attorneys fees, expenses,  
8 and costs in this action; and

9 E. Issue such other and further relief as this Court deems just and proper.

10 **DEMAND FOR JURY TRIAL**

11 Pursuant to Federal Rule of Civil Procedure 38(b) and Northern District of California Local  
12 Rule 3-6(a), SanDisk respectfully requests a trial by jury of all matters to which it is entitled to a trial  
13 by jury.

14  
15 Dated: October 27, 2011

Respectfully Submitted,

VINSON & ELKINS LLP

16  
17  
18 By: 

19 Chuck P. Ebertin

20 Attorneys for Plaintiff  
21 SANDISK CORPORATION  
22  
23  
24  
25  
26  
27  
28